

REMARKS

Claim Amendments

Claims 20-21 and 41. Claim 20 has been amended to specify that C is cytosine, G is guanosine, C* is selected from 5-hydroxycytosine, 5-hydroxymethylcytosine, N4-alkylcytosine, aracytosine and 4-thiouracil, and G* is selected from 7-deazaguanosine and 6-thioguanosine. New claim 52 specifies that G* is 6-thioguanosine. No new matter has been added.

Written Description

Claims 20, 21 and 41 are currently rejected under 35 U.S.C. § 112, first paragraph as failing to meet the written description requirement. The essence of this rejection is that C encompasses any natural pyrimidine, G encompasses any natural purine, G* encompasses any modified purine, and that different functional effects would be expected for different structures within this broad class of compounds. This rejection has been overcome by amendment.

Claim 20 has been amended to specify that C is cytosine, G is guanosine, C* is selected from 5-hydroxycytosine, 5-hydroxymethylcytosine, N4-alkylcytosine, aracytosine and 4-thiouracil, and G* is selected from 7-deazaguanosine and 6-thioguanosine. The Office action notes that the specification provides specific written description for 5-hydroxycytosine, N4-ethylcytosine and 7-deazaguanosine as modifications within the CpG motif (page 4, last paragraph). The specification also provides specific written description for aracytosine (Figure 25), 4-thiouracil (Figure 26) and 6-thioguanine (Figure 22). In addition, 5-hydroxymethyl is structurally similar to 5-hydroxycytosine and is similarly active. Thus, Applicants respectfully submit that amended claim 20 satisfies the written description requirement and request that this rejection be withdrawn.

Double Patenting

Claims 20-21 and 41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over various claims of U.S. Patents Nos. 7713535 and 7709617.

Without admitting the obviousness of claims 20-21 and 41 over any of these claims, and solely for the sake of expediting prosecution, Applicants submit herewith a terminal disclaimer

over US Patents Nos. 7713535 and 7709617. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Claims 20-21 and 41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over various claims of co-pending US Applications Nos. 11/174450, 11/641551, 11/906781, 10/865245, 10/892550, 11/641590, 11/060228 and 11/153054. Of these, Applications Nos. 11/174450, 11/641551 and 11/906,781 have been allowed. Without admitting the obviousness of claims 20-21 and 41 over any of these claims, and solely for the sake of expediting prosecution, Applicants submit herewith a terminal disclaimer over Applications Nos. 11/174450, 11/641551 and 11/906,781. Accordingly, Applicants respectfully request that this rejection be withdrawn.

All of the other applications are still pending and have later priority dates than the instant application. MPEP § 804(B)(1) provides, in relevant part, that “If a ‘provisional’ nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.”

Applicants respectfully submit that the amendment of claim 20 has overcome the rejection of that claim for failure to meet the written description requirement, that the ODP rejections over Applicants’ own patents and allowed applications has been overcome by timely submission of a terminal disclaimer, and thus, that these provisional ODP rejections are the only rejections remaining in the instant, earlier-filed application. Thus, Applicants respectfully request that the instant application be passed to issue without a terminal disclaimer over the pending applications.

CONCLUSION

In view of the above amendments and remarks, it is believed that claims 20-21 and 41 are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner believes that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned attorney at 207-791-3078.

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Dated: September 23, 2010

Preti Flaherty
One City Center
Portland, ME 04112
Telephone: 207/791-3000
Facsimile: 207/791-3111

Respectfully submitted,

By: /Wayne A. Keown/
Wayne A. Keown, Ph.D.
Registration No. 33,923